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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/971,976	10/04/2001	Richard Lawn	32136191.10	5692

23562 7590 06/17/2003

BAKER & MCKENZIE  
PATENT DEPARTMENT  
2001 ROSS AVENUE  
SUITE 2300  
DALLAS, TX 75201

EXAMINER
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RODRIGUEZ, PAUL L

ART UNIT	PAPER NUMBER
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2125

DATE MAILED: 06/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

PR2

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/971,976	LAWN ET AL.	
	Examiner	Art Unit	
	Paul L Rodriguez	2125	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 October 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____.  |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)              | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>3</u> . | 6) <input type="checkbox"/> Other: _____.                                   |

### **DETAILED ACTION**

1. Claims 1-6 are presented for examination.

#### ***Priority***

2. Examiner acknowledges applicant's claimed priority to Provisional application 60/238,176 as recited on the submitted Declaration, however examiner would like to point out that the recitation of priority in the first sentence of the specification claims priority to 60/238,716 and not the document listed on the Declaration.

#### ***Information Disclosure Statement***

3. The information disclosure statement filed 3/26/03 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the Non Patent Literature information referred to therein has not been considered. Copies of Non Patent Literature documents (MEIER and BAJAJ) were not in the file wrapper and could not be considered by the examiner.

#### ***Oath/Declaration***

4. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not identify the mailing or post office address of each inventor. A mailing or post office address is an address at which an inventor customarily receives his or her mail and may be either a home or business address. The mailing or post office address should include the ZIP Code designation. The mailing or post office address may be provided in an application data sheet or a supplemental oath or declaration. See 37 CFR 1.63(c) and 37 CFR 1.76.

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Examiner found that the Declaration stated on page one "...our residence, mailing address and citizenship are stated below..." however page two of the declaration only lists residence and citizenship and does not indicate an address.

### ***Drawings***

5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 225. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Specification***

6. The disclosure is objected to because of the following informalities:

Page 5 line 2 refers to "CIE 1976 L\*a\*b format", unclear if this is referring to an acronym, if so a definition of the acronym during the first use in the specification would be beneficial.

Page 7 line 6 refers to figure 3 as "a block diagram of a database", figure 3 appears to be a sphere depicting a color designation and not a block diagram.

Page 10 lines 6-10 states that application program 215 is stored in 205, figure 2 displays 215 outside of reference number 205.

Page 10 line 17 refers to "communication channel 225", reference number not found in figures.

Page 11 line 22 states "mature", possible typographical error, "nature" would seem more appropriate.

The specification uses the word "internet", lower case "i" internet is defined as a set of computer networks that may be dissimilar and are joined together by means of gateways. Upper

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case "I" Internet is defined as the worldwide collection of networks and gateways that use the TCP/IP suite of protocols to communicate with one another. Applicant should make the proper reference in the specification.

Appropriate correction is required.

7. The examiner has provided a number of examples of the specification deficiencies in the above, however, the list of deficiencies may not be all inclusive. Applicant should refer to these as examples of deficiencies and should make all the necessary corrections to eliminate the specification objections.

***Claim Rejections - 35 USC § 112***

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-3 and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. Claim 1 recites the limitation "said color exchange" in line 2. There is insufficient antecedent basis for this limitation in the claim.

10. Claim 6 recites the limitation "the client terminal" in lines 4-5. There is insufficient antecedent basis for this limitation in the claim.

11. The examiner has provided examples of the claim deficiencies in the above rejection(s), however, the list of rejections may not be all inclusive. Applicant should refer to these rejections

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as examples of deficiencies and should make all the necessary corrections to eliminate the 35 USC § 112 second paragraph problems and place the claims in a proper format.

***Claim Rejections - 35 USC § 102***

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

13. Claims 1-6 are rejected under 35 U.S.C. 102(e) as being anticipated by Yon et al (U.S. Pat 6,507,824). The claimed invention reads on Yon et al as follows:

Yon et al discloses (claim 1) an algorithm exchange (defined by applicant as linking users to developers and storing information regarding coloring algorithms, reference number 14, col. 2 lines 48-50, col. 4 lines 26-41) for providing access to coloring algorithms (defined by applicant as used to calculate a resulting recipe or color recommendation, col. 3 lines 24-34, col. 7 lines 45-67, examiner considers the selection of a specific product or vendor, tied to available colors as accessing a color algorithm because the selection of a product provides the potential customer with the “n” closest available colors) said color exchange comprising a server (reference numbers 20, col. 2 lines 48-50) for providing access to a plurality of coloring algorithms to a client (reference number 18) computer (col. 2 lines 48-50, col. 3 lines 29-34, col. 4 lines 26-28) and a database (reference number 16) for storing a plurality of color measurements for use as inputs to the coloring algorithms (col. 2 lines 30-33, col. 4 lines 26-34, col. 5 lines 1-13), (claim 2) wherein the database stores the plurality of coloring algorithms (col. 3 lines 29-34, col. 7 lines

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51-62, database stores product, vendor and color data used to make color recommendations), (claim 3) wherein the server further comprises a computer readable medium (col. 8 lines 13-32) for storing a script program (defined by applicant to provide access to application programs and display web pages, col. 8 lines 3-21) said script program providing access to the plurality of coloring algorithms (col. 2 lines 39-50, col. 8 lines 3-11), (claim 4) a method for using a coloring algorithm (col. 1 lines 52-62, col. 3 lines 24-34), said method comprising receiving a selection from a client computer (reference number 18) of a particular one of a plurality of coloring algorithms (col. 3 lines 29-34, the selection of a product considered the selection of a specific color algorithm) at a server computer (reference numbers 14) and receiving color measurements as inputs to the particular one of the plurality of coloring algorithms (col. 3 line 45 – col. 4 line 28), (claim 5) wherein receiving color measurements further comprises receiving a selection from the color measurements from a database at the server (col. 4 lines 26-50, col. 5 lines 1-9, “available colors”) and (claim 6) wherein receiving color measurements further comprises receiving the color measurements from the client terminal (col. 3 line 45 – col. 4 line 28, “target color”).

### ***Conclusion***

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Sano et al (U.S. Pub. No. 2001/0052904 A1) – teaches an Internet based color matching calculating system that uses stored data to calculate a blending ratio of colorants based on a desired target color.

Numata et al (U.S. Pat 6,539,325) – teaches a color matching apparatus for matching repair paint colors using a remote database server and a color data file.

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Ganapathy et al (U.S. Pat 6,411,953) – teaches a system for matching colors using one or more dimensions to define a specific color, the system is configured with a user terminal, network and remote server to perform color matching.

Chan (U.S. Pat 6,342,952) – teaches a system and method for matching ink colors over a computer network.

Kumada (U.S. Pat 6,337,922) – teaches a server based color matching system for image processing, wherein the server stores device profiles and color management modules

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul L Rodriguez whose telephone number is (703) 305-7399.

The examiner can normally be reached on 6:00 - 4:30 T-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo P Picard can be reached on (703) 308-0538. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9600.



Paul L Rodriguez  
Examiner  
Art Unit 2125

PLR  
June 12, 2003